

pg



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,578	04/05/2001	Douglas C. Osburn III	782.03	2996

7590 10/04/2004

Wendy K. Buskop
Buskop Law Group, P.C.
1717 St. James Place, Suite 500
Houston, TX 77056

EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,578

Applicant(s)

OSBURN, DOUGLAS C.

Examiner

Bharat N Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-12, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) 4-6 and 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) #
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

2. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitations "The method" in line 1 and claim 3 recites the limitation "the configuration functionality" in line 1. There are insufficient antecedent basis for these limitations in the claims 1-3.

Art Unit: 2155

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-3, 8-12, and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Blackett et al (U.S. Patent No. 6,751,562). Blackett's patent meets all the limitations for claims 1-23 recited in the claimed invention.

7. As to claim 1, Blackett et al teach a method for communication for a supervisory control and data acquisition (SCADA) system (abstract; and column 3 line 30 to column 4 line 7), the SCADA system comprising: an enterprise server (electric power distribution system with back end server) (figure 1; and column 9 lines 9-65); at least one intelligent electronic device (IED/RTU), wherein the RTU measures a physical process and stores digital data representative of the measurement in a memory area for transmission; and the RTU has software that includes a generic encapsulation layer (GEL) and automation software (figures 2s-3s; column 10 line 57 to column 11 line 60; and column 12 line 51 to column 15 line 46); and a communication software (DCI/AES) linking the enterprise server with the at least one RTU (figure 2a; and column 10 line 57 to column 11 line 30).

Art Unit: 2155

8. As to claim 2, Blackett et al teach a method comprising the steps of: communicating a command from the enterprise server to the RTU via the AES to configure the RTU; permitting the RTU to receive data input and to store the data; and transmitting the data back from the RTU to the AES and the enterprise server (figures 1, 2a-2b, and 3a; column 10 line 57 to column 11 line 30; and column 12 line 51 to column 13 line 50).

9. As to claim 3, Blackett et al teach that configuration functionality is communicated to the RTU without the use of primary signal injection equipment using the AES (column 24 line 25 to column 25 line 15).

10. As to claim 8, Blackett et al teach that the RTU continues to operate the automation software while receiving communication commands and executing reconfiguration commands (column 24 line 62 to column 25 line 15).

11. As to claims 9-12, Blackett et al teach that the AES continues communicating with connected RTUS while an additional enterprise server is added to the SCADA system or removed from the SCADA system and an additional RTU is added to the system or deleted from the system (figures 1 and 6-8; column 9 lines 9-65; column 19 lines 1-47; and column 19 line 64 to column 20 line 39).

Art Unit: 2155

12. As to claims 17-18, Blackett et al teach that the RTU is configured with configuration software; and the AES utilizes separate configuration software (column 11 lines 18-30; column 17 lines 48-62; column 21 lines 47-55; and column 23 line 56 to column 25 line 15).

Claim Objections

13. Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other dependent claims 6-7 and 13-16, which are not specifically cited above are also objected because of the deficiencies of their respective parent claims.

Additional References

14. The examiner as of general interest cites the following references.

- a. Osburn, III, U.S. Patent No. 6,628,992.
- b. Steger et al, U.S. Patent No. 6,411,987.
- c. Coleman et al, U.S. Patent No. 6,032,154.
- d. Coleman et al, U.S. Patent No. 5,794,009.

Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (703) 305-4092. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, can be reached at (703) 308-6662. A central official fax number is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2155

September 29, 2004

Bharat Barot.

**BHARAT BAROT
PRIMARY EXAMINER**